

**REMARKS**

- Claims 1 – 76 are currently pending in the Application.
- Of the pending claims, only claims 1, 12, 21, 33 – 35, 37, 38, 43, 45, 47 – 49, 51, 56, 58, 60 – 62, 64, 69, 71 and 73 – 75 are independent.
- A restriction requirement has been imposed on the pending claims.

In response to the restriction requirement imposed by the Examiner at this stage of prosecution, Applicants provisionally elect to prosecute Group I (including claims 1-11 and 38 - 42). Further, as discussed in detail below, Applicants respectfully submit that the claims of Group VIII (claims 51 – 55) are linking claims and thus must be examined with the claims of Group I.

This provisional election is made with traverse. That is, Applicants respectfully disagree with the Examiner's proposed restriction. Applicants request reconsideration of the restriction requirement in light of the following arguments, and pursuant to 37 CFR §1.143.

***1) Establishing a Prima Facie Case for Restriction***

Restriction of the pending claims is not believed to be appropriate in this case. Specifically, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case for restriction.

**a) Proper Basis for Restriction**

**i) Generally**

Restriction is proper only where an application contains claims directed to two or more independent or distinct inventions. (MPEP §802.01).

The term "independent" is defined as meaning "that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect". (MPEP §802.01). To establish a *prima facie* case for restriction where the basis for restriction is that the different inventions being claimed are "independent", the Examiner must demonstrate "the reasons...why the inventions as claimed are...independent". (MPEP §808).

The term "distinct", as used in restriction practice, means that two or more claimed subjects are "(1) capable of separate manufacture, use or sale; and (2) are patentable over each other". (*Id.*). To establish a *prima facie* case for restriction where the basis for restriction is that the inventions are "distinct", the Examiner must establish (1) "the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are...distinct", and (2) "the reasons for insisting upon restriction therebetween". (MPEP §808).

**ii) Combination and Subcombination**

In some cases, claims may be directed to combinations, subcombinations, or elements of a combination. For restriction of combination and subcombination claims to be proper, "both two-way distinctiveness and reasons for insisting on restriction are necessary." (MPEP §806.05(c)). In particular, the inventions are distinct if the claimed combination (1) "does not require the particulars of the subcombination as claimed for patentability", and (2) "the subcombination can be shown to have utility either by itself or in other and

different relations". (*Id.*) "Where these factors can not be shown, such inventions are not distinct." (*Id.*)

### **iii) Process and Apparatus for Practice (Statutory Class)**

In some cases, claims may be directed to a process and an apparatus for practicing the claimed process. To support a restriction requirement for claims directed to different 35 USC §101 statutory classes (i.e., process, apparatus, etc.), a form of "distinct"-based restriction must be shown. For restriction to be proper, "[p]rocess and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another and materially different process." (MPEP §806.05(e)). "The burden is on the examiner to provide reasonable examples that recite material differences." (*Id.*) Further, "[i]f the apparatus claims include a claim to 'means' for practicing the process, the claim is a linking claim and must be examined with the elected invention." (*Id.*)

### **b) The Examiner's Case as Set Forth**

The Examiner supports the present restriction with the following two conclusory statements:

- (i) “[The inventions] are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable.”

- (ii) “[The inventions] are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process.”

Neither of these statements satisfies the Examiner's burden of establishing a *prima facie* case for restriction under MPEP §808, for either "independent" or "distinct"-based restrictions. This statement also fails to establish a *prima facie* case for restriction of subcombination/combination claims or process and apparatus for its practice, as explained in detail below.

**c) Incorrect Basis for Restriction**

In assertion (i) above, Examiner states that various groups are related as subcombination and subcombination. However, this is not a proper basis for restriction. The only proper basis for restriction that Applicants can fathom the Examiner is attempting to rely upon is the combination/subcombination basis. As explained above and in the MPEP, in order for this basis to apply to two claims, one claim must be directed to a combination and the other claim to a subcombination of the combination, and the combination and subcombination must pass the two-way distinctiveness test. The example provided in the MPEP to a subcombination / combination is the following: a combination claim including element B (B being broad or narrow) and a subcombination claim including element B and element A. MPEP §806.05(c) I and II. If two claims are each directed to a respective subcombination, as it appears the Examiner is asserting as

the reason for the restriction requirement among a majority of the groups, this is immaterial to restriction practice as restriction practice does not contemplate a restriction among two subcombinations that are “usable together in a single combination.”

Applicants respectfully note that two claims that share a common element are not a combination and subcombination merely because of the shared element (a claim to AB is not a combination or subcombination of a claim to CB). None of the pending claims can be identified as AB or B; B being broad or narrow, as described in MPEP §806.05(c) I and II.

In summary, Applicants respectfully submit that the Examiner, in relying upon a subcombination / subcombination basis for insisting on a restriction among a majority of the groups, has relied on improper grounds for imposing the present restriction requirement. Accordingly, Applicants respectfully request that the restriction requirement be withdrawn.

**d) A *Prima Facie* Case for "Independent" Restriction has not been Established**

The Examiner makes no statements alleging that the claimed inventions are "independent". However, even if the Examiner had intended to impose the restriction based on "independent" inventions, the *prima facie* burden has still not been met. Applicants respectfully point out that "independent" inventions, as defined in restriction practice, are "not connected in design, operation, or effect" (MPEP §802.01, 808.01), and are "not capable of use together" (MPEP §§808.01, 806.04). An example of "independent" inventions would be claims directed to both "a necktie and a locomotive bearing". (MPEP §808.01 at Examiner Note 1; see

also, MPEP §806.04, "a shoe, and a locomotive bearing"). Clearly, where all currently claimed embodiments of the present invention are related to methods, apparatus, and articles of manufacture for facilitating an offer based on received information, no such independence exists.

**e) A *Prima Facie* Case for "Distinct" Restriction has not been Established**

Alternatively, even if the Examiner had intended to impose the restriction based on "distinct" inventions, the *prima facie* burden has still not been met. No reasons for believing the claimed inventions are "distinct" have been set forth, nor has the second requirement of presenting reasons for insisting upon restriction been complied with. The Examiner has failed to show that (1) that each claimed invention "has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search", (2) that even if classified together they have formed separate subjects for inventive effort, or (3) that a different field of search is required. (MPEP §808.02). To the contrary, the Examiner has admitted that all of the groups may be searched within the same class (class 705) and subclass (subclass 26) and has previously successfully searched all of the pending claims.

Absent such showings as required by MPEP §808.02, no *prima facie* case for restriction under the "distinct" theory is established.

Where "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions." (*Id*).

**f) A *Prima Facie* Case for "Combination and Subcombination"**  
**Restriction has not been Established**

As discussed above, in order to establish a prima facie case for a combination / subcombination restriction requirement, it is the Examiner's burden to show that the two-way distinctiveness test has been satisfied and, in particular, the claimed combination (1) "does not require the particulars of the subcombination as claimed for patentability", and (2) "the subcombination can be shown to have utility either by itself or in other and different relations".

In the present Application the Examiner has failed to satisfy this prima facie burden for at least the following reasons: (i) the Examiner has not identified *any* combination claim, and (ii) the Examiner has utterly failed to even address the two-way distinctiveness test. The Examiner has merely asserted that the alleged subcombinations "are separately usable", which does not satisfy the Examiner's burden.

**g) A *Prima Facie* Case for "Process and Apparatus for Practice"**  
**Restriction has not been Established**

The Examiner is relying upon the assertion that the methods of the various groups "can be practiced by hand" as the reason for imposing the statutory class restriction requirement among some of the groups. However, Applicants are confused as to this reasoning, as Applicants amended (in the prior Amendment and Response to the March 18, 2004 Office Action) each of the independent method claims to explicitly "recite technology in a non-trivial manner" in order to overcome a §101 rejection imposed in the prior Office Action that was based on an assertion that the methods can be "practiced by hand." Accordingly, the

Examiner's reason for insisting upon this restriction requirement appears to ignore the prior amendment to the method claims.

## **2) *The Examiner has Failed to Establish an Undue Burden***

Even if a *prima facie* case for restriction establishes that an application includes independent or distinct inventions, restriction is not proper "[i]f the search and examination of [the] entire application can be made without serious burden." (MPEP §803). Applicants respectfully assert that restriction is not proper in this case because there is no indication that any serious burden exists. In particular, (1) there is no separate classification of the alleged species which would necessitate a separate field of search (the Examiner admits that all of the claims can be classified into the same class and subclass); (2) the alleged species can be searched using the same field of search without unduly burdening the Examiner; and (3) the alleged species are not related to any class of invention which has achieved a separate status in the art. (see, MPEP §808.02). In general, Applicants believe that the claims all can readily be searched and examined together without undue burden on the Examiner. Indeed, such a non-burdening search has already been conducted. Thus, even if the Examiner had set forth a *prima facie* case for restriction and had imposed the restriction requirement at an appropriate time (in a first office action), restriction would still not be proper in this case.

Therefore, because all pending claims are associated with the same classifications, groups I through XIX may be searched using the same fields of search, posing no burden to the Examiner.

## **3) *Linking Claim***



Group VIII is directed to an apparatus for practicing the methods of Group I and includes 'means' for practicing the method. As discussed above, "[i]f the apparatus claims include a claim to 'means' for practicing the process, the claim is a linking claim and must be examined with the elected invention." MPEP §806.05(e), emphasis added. Accordingly, Applicants respectfully submit that claims 51 – 55 (the claims included by the Examiner in Group VIII) must be examined along with the provisionally elected claims of Group I.

#### ***4) Conclusion***

In view of the foregoing, Applicants respectfully request that the restriction requirement be withdrawn upon reconsideration. All claims currently remain in the case and are believed patentable. Applicants respectfully request allowance of the pending claims. Applicants' silence with respect to other comments made in the Office Action (e.g., comments directed to various dependent claims) does not imply agreement with those comments.

## C O N C L U S I O N

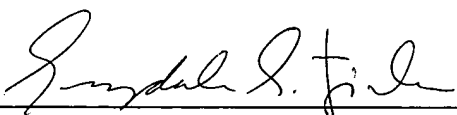
For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number (203) 461-7041 or via electronic mail at [mfincham@walkerdigital.com](mailto:mfincham@walkerdigital.com).

Applicants do not believe any fee (e.g., for an extension of time with which to respond to the Office Action) is required at this time. However, if a fee should be necessary for the present Application at this time (or any time during the prosecution of the present Application), please charge any such required fee to our Deposit Account No. 50-0271. Please credit any overpayment to Deposit Account No. 50-0271.

Respectfully submitted,

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Date

  
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